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10/524,354	02/14/2005	Koichi Goto	450100-05121	6316

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EXAMINER	
KARIMI, PEGEMAN	
ART UNIT	PAPER NUMBER
2629	
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02/02/2010	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No.	Applicant(s)	
	10/524,354	GOTO ET AL.	
	Examiner	Art Unit	
	PEGEMAN KARIMI	2629	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE *3* MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *28 October 2009*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1,2,4-6 and 8-20* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1, 2, 4-6, 8-20* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED ACTION

Response to Amendment

1. The amendment filed on 10/28/2009 has been entered and considered by the examiner.

Claim Rejections - 35 USC § 103

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

3. Claims 1, 2, 4-6, and 8-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Beernink (U.S. Patent No. 5,434,929) in view of by Dolan (U.S. Patent No. 5,148,015) and further in view of Dutta (U.S. Pub. No. 2002/0073204) and Cline (U.S. Patent No. 5,745,718).

As to claims 1 and 11, Beernink teaches an input method using a touch panel input apparatus (10) in which

a touch panel (52 and 24') is laminated onto a display screen (72) of a display apparatus (50), (col. 5, lines 61-64),

a sensor unit (72) is formed so as to be expanded to the outside of one side of said display screen (i.e. 72 includes display screen 52 and keypad 24'. Keypad 24' is arranged outside of the side screen 52), (col. 4, lines 36-39)

an instruction (pop-up window of command icon) according to a touching position of a finger or a touch pen (38) onto said sensor unit is given (col.7, lines 39-47), and

a controller (18) generates a control signal on the basis of said instruction (col. 4, lines 1-2),

comprising the steps of:

displaying a selection display (76) comprising a plurality of selection items (82) along said side of said display screen (Horizontal side of the display) when the finger or the touch pen (38) is touched to said sensor unit (col. 8, lines 49-51, and lines 58-60);

and selecting said highlighted selection item upon lifting the finger or the touch pen (highlighting the elements of selection items 82 by touch pen 38 and selecting a desired selection by placing the touch pen on the screen and then lifting the touch pen), (col. 7, lines 45-50) from contact with said sensor unit (placing and then lifting the touch pen from the touch screen 51) near the highlighted selection item and (col. 9, lines 43-49), [[wherein said selection display disappears when the finger or the touch pen is moved (lifted) from said sensor unit to said display screen side]] (tapping on box 94, which is located on the display screen side, col. 9, lines 15-19), (col. 7, lines 47-50).

Beernink does not mention highlighting selection item as the finger or touch pen moved along said side on said sensor unit. Dolan teaches instructing one of (as can be seen in Fig. 1, when the user places his/her finger on sensor 15' the selection option 25 is highlighted) highlighting said highlighted selection items when the finger or the touch pen is near said selection items (col. 4, lines 56-63) as the finger or touch pen remains

in contact with said sensor unit (as the user places his/her finger over the sensor the photo detector has activated and causes the selection to be highlighted) and is moved along said side on said sensor unit (col. 4, lines 64-67). Therefore it would have been obvious to one of ordinary skilled in the art at the time the invention was made to have added the highlighting selection item by the finger or the touch pen of Dolan to the input apparatus of Beernink because The highlighting of the desired selection by the user placing his finger over a reflective sensor lined up with the displayed item will normally be sufficient to inform the user of the choice that the has elected (col. 5, lines 6-9).

Beernink and Dolan do not teach closing the selection display when the finger or the touch pen remains in contact while moved from said sensor unit to said display screen on said touch panel. Dutta teaches closing a selection display (pop-up box containing data items) when the finger or the touch pen (cursor, which acts as a touch pen) remains in contact (moving the cursor over other host identifiers) while moved from said sensor unit (host identifier) to said display screen on said touch panel (in order to move from one host identifier to another the user must move over the display screen on the touch panel as can be seen in Fig. 6. when the user moves the cursor from one host identifier to another the pop-up box will open and close with the appropriate information). It should be noted that the prior art of Dutta does not mention a finger or a touch pen moving from the sensor unit to the display screen, however, Beernink teaches a touch pen 38, which can be used to move the cursor on the screen instead of the mouse or keyboard of Dutta. Therefore since the cursor is moved from one host identifier to another and opens and closes the pop-up box data information, it can be

concluded that when the touch pen is controlling the cursor in order for the cursor to move from one host identifier to another the stylus must remain in contact with the sensor unit.

Therefore it would have been obvious to one of ordinary skilled in the art at the time the invention was made to have added the cancelling a selection display when the finger or the touch pen remains in contact while being moved from said sensor to the display screen on said touch panel of Dutta to the touch panel of Beernink as modified by Dolan because it would help the user to search faster and find information regarding a selection display faster through the menu options by eliminating the taping or double clicking.

Beernink, Dolan, and Dutta do not specifically mention a single touch and release operation of the finger or the touch pen with the sensor unit executes both an operation to display the selection display and an operation to select a desire selection item.

Cline teaches a single touch and release operation of the finger or the touch pen (pointing device) with the sensor unit executes both an operation to display the selection display and an operation to select a desired selection item in the selection display (by single clicking on a tab, the drop down menu, which is the selection display is displayed, also by clicking on an object within a drop-down menu the user can select the object (col. 4, lines 28-35), (therefore the user can operate both display the selection display and select a desire selection item with in the selection display by a single click, which is a click and release of the button. Therefore it would have been obvious to one of

ordinary skilled in the art at the time the invention was made to have added the using a single touch and release (single-click) to display a selection display and also selecting an object in a drop-down menu of Cline to the display device of Beernink's sensor unit 72 as modified by Dolan and Dutta because the user can easily operate two different functions of displaying a selection display and selecting an object from a drop-down menu by a single click and use a single click for each of the operations. (KSR International Co. v.Teleflex Inc.)

As to claims 5 and 12, these claim differs from claim 1 only in that the limitations "a controller to which an instruction according to a touching position of a finger or touch pen onto said sensor unit is given".

Claims 5 and 12 also differ in the term "cancelling" and "closing" a selection display, which are both thought by the prior art reference of Dutta. The cancelling or closing the selection display is when the user moves the cursor from one host identifier to another the pop-up box will open and close (gets cancelled) with the appropriate information.

Beernink teaches a controller (18) to which an instruction (pop-up window of command icon) according to a touching position of a finger or touch pen (38) onto said sensor unit is given (col. 7, lines 39-47), (the display assembly 20 of pen-based computer system 10 is both an input and an output device and is coupled to I/O circuitry 18 by a bi-directional data bus 37, also when the buttons are selected by engaging the touch pen 38 the pressure is sensed and communicated to CPU 12 via data bus 37 and I/O 18, Fig. 1).

As to claims 2 and 6, Beernink teaches, operating a predetermined button (64) on a display/sensor unit of said touch panel (24') overlapped with said display screen (24' overlaps 72), an instruction corresponding to said button is generated (col. 5, lines 23-27 and col. 7, lines 39-42).

As to claims 4 and 8, Beernink teaches the selection display is a menu display (col. 7, lines 45-47).

As to claim 9 and 10, Beernink teaches a selection operation is cancelled (quitting a session setting preference) and said selection display is continued when the finger or the touch pen is moved along said sensor unit to an end area of said sensor unit out of range of said selection items on said display screen (when the pen is moved to the close box 94, which is out of range of the selection items of the display screen and is at the end of the sensor unit, the user can select the close box 94 by tapping on the close box to quit a session setting preference and continue working on the display) and thereafter lifting up the finger or touch pen from said sensor unit to said display screen side (the tapping of the close box 94 requires the user to press the pen on the close box and then lift the pen in order to select the close box 94), (col. 9, lines 15-19).

As to claim 13, Beernink teaches the touch panel (touch panel is the sections 20 and 24' combined as can be seen in Fig. 1 because section 20 can be an input device, which is qualified as touch panel section col. 3, lines 65-66) is larger than the display screen (the display area is the area 20).

As to claim 14, Beernink teaches the touch panel (areas 20 and 24' combined) includes:

(a) a display/sensor unit (areas 20 and 24' combined) larger than the display screen (20 is also the display screen therefore the combined areas 20 and 24' is larger than the display screen 20 alone) and (b) the sensor unit (col. 4, lines 42-45).

As to claim 15, Beernink teaches the touch panel (touch panel is the sections 20 and 24' combined as can be seen in Fig. 1 because section 20 can be an input device, which is qualified as touch panel section col. 3, lines 65-66) is larger than the display screen (the display area is the area 20).

As to claim 16, Beernink teaches the touch panel (areas 20 and 24' combined) includes:

(a) a display/sensor unit (areas 20 and 24' combined) larger than the display screen (20 is also the display screen therefore the combined areas 20 and 24' is larger than the display screen 20 alone) and (b) the sensor unit (col. 4, lines 42-45).

As to claim 17, Beernink teaches the step of providing the touch panel (touch panel is the sections 20 and 24' combined as can be seen in Fig. 1 because section 20 can be an input device, which is qualified as touch panel section col. 3, lines 65-66, the touch panel 20 can be used as an input device by using a stylus 38, therefore the area

20 can be part of the touch panel) to be larger than the display screen (the display area is the area 20).

As to claim 18, Beernink teaches the step of providing the touch panel (areas 20 and 24' combined are the touch panel area because the area 20 can be used as an input device using the stylus 38) includes:

(a) a display/sensor unit (areas 20 and 24' combined) larger than the display screen (20 is also the display screen therefore the combined areas 20 and 24' is larger than the display screen 20 alone) and (b) the sensor unit (col. 4, lines 42-45).

As to claim 19, Beernink teaches the step of providing the touch panel (touch panel is the sections 20 and 24' combined as can be seen in Fig. 1 because section 20 can be an input device, which is qualified as touch panel section col. 3, lines 65-66, the touch panel 20 can be used as an input device by using a stylus 38, therefore the area 20 can be part of the touch panel) to be larger than the display screen (the display area is the area 20).

As to claim 20, Beernink teaches the step of providing the touch panel (areas 20 and 24' combined are the touch panel area because the area 20 can be used as an input device using the stylus 38) includes:

(a) a display/sensor unit (areas 20 and 24' combined) larger than the display screen (20 is also the display screen therefore the combined areas 20 and 24' is larger than the display screen 20 alone) and (b) the sensor unit (col. 4, lines 42-45).

Response to Arguments

4. Applicant's arguments filed 10/28/2009 have been fully considered but they are not persuasive.

Applicant argues that nothing in Beernink shows, teaches, or suggests both an operation to display a selection display and an operation to select a desired selection item in the selection display are executed by a single touch and release operation of a finger or touch pen with a sensor unit as claimed in claims 1, 5, 11, and 12.

Examiner would like to point out that Cline teaches that with a single click, a user can both execute displaying the menu and select an object. This limitation can be interpreted as a single click can execute displaying a menu and a single click can select an object on the screen. Therefore a single click can execute both an operation to display selection display and an operation to select a desired selection item in the selection display.

Applicant argues that nothing in Cline shows, teaches, or suggests a touch panel input apparatus in which a touch panel is laminated into a display screen of a display apparatus and a sensor unit is formed so as to be expanded to the outside of one side of the display screen.

Examiner would like to point out the above mentioned limitation is taught by Beernink rather than Cline. Beernink teaches the keypad area 24', which is part of the display screen sensor area has a printed member 60 provided beneath a lower edge of a thin clear, stylus sensitive membrane 62 of the input device.

Applicant further argues that references of Dolan and Dutta do not teach the limitation of both an operation to display a selection display and an operation to select a desired selection item in the selection display are executed by a single touch and release operation of a finger or touch pen with a sensor unit as claimed in claims 1, 5, 11, and 12.

As was explained above the prior art reference of Cline teaches this limitation.

Conclusion

5. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

6. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Reynar (U.S. Pub. No. 2004/0001099) teaches a user hovers a cursor over a string or places the insertion point within a string in a section of the document incorporating a semantic label causing a dropdown menu to be displayed to the user.

Holtzblatt (U.S. Pub. No. 2001/0038395) teaches FIG. 10 shows the drop-down menu 610 and the menu choices that pop-up in preview panel 220 after a user hovers over the "Collaboration" element of the page.

Inquiry

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to PEGEMAN KARIMI whose telephone number is (571)270-1712. The examiner can normally be reached on Monday-Thursday 9:00am - 5:30pm EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Chanh Nguyen can be reached on (571) 272-7772. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Pegeman Karimi/
Examiner, Art Unit 2629
January 29, 2010

/Chanh Nguyen/
Supervisory Patent Examiner, Art Unit 2629